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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/650,034	08/29/2000	Brian Siegel	SNY-P4055.01	8387

24337 7590 06/17/2003

MILLER PATENT SERVICES
2500 DOCKERY LANE
RALEIGH, NC 27606

EXAMINER

SHIH, SALLY

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 06/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/650,034

Applicant(s)

SIEGEL, BRIAN

Examiner

Sally Shih

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 19 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-57 is/are rejected.
- 7) ☒ Claim(s) 54-57 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. This communication is response to Applicant's amendment filed on March 19, 2003.

The rejections are as stated below:

Status of Claims

2. Of the original claims 1-53, Claims 1-4, 9, 12-17, 19, 24, 30, 31, 35, 38, 39, 41, 43-46, 49 and 50 have been amended. Additionally, the applicant has added claims 54-57. Therefore, claims 1-57 are under prosecution in this application.

Summary of this Office Action

3. Applicant's arguments filed on March 19, 2003 have been fully considered, and discussed in the next section below or within the following rejection are not deemed to be persuasive. Therefore, claims 1-57 are rejected as being unpatentable over the art cited below, and Applicant's request for allowance is respectfully denied.

Response to Applicant's Amendment

4. The amended title has been accepted and entered into the record. Additionally, the Examiner acknowledges Applicant's additional claims 54-57. Please see below for objection and rejection with respect to these claims.

Claim Objections

5. Claims 54-57 are objected due to the use of trademark. The use of the trademark SIDECAR has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 54-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wong et al. (United States Patent Number 6,119,933).

7. Claims 54-57: Wong et al. teach the method, system and storage medium of tracking online credit card usage by a user (Abstract and Fig. 6A-6C). However, Wong et al. does not explicitly disclose the background process being carried out in a "sidecar" application. Please note that a "sidecar" application is an application that contains memory and microprocessor components. A fully integrated unit would not require a sidecar. However, a functional

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equivalent of a “sidecar” application or components (Fig. 1) would have to exist in order to carry out the remote data capture functions described in Wong et al. such as smart card reader, magnetic and biometric input device (Column 1, lines 19-31). The examiner takes Official Notice that personal computing devices contain memory and microprocessor components are old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teaching of Wong et al. to include memory and microprocessor components to provide an additional stream of data from a content provider. The use and advantages of this step are well known.

Response to Applicant’s Argument

8. The Examiner acknowledges Applicant’s arguments with respect to claims 1-53. The Applicant’s arguments have been fully considered, and discussed in the next section below are not deemed to be persuasive.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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10. Claims 1-53 are rejected under 35 U.S.C. 102(e) as being anticipated by Wong et al. United States Patent Number 6,119,933 as discussed from the fourth paragraph of page 2 of paper number 4.

11. The applicant argued that claims 1-30 and 39-45 have been amended to reflect the use of a background process. In response to applicant's argument that a background process is not explicitly disclosed within the cited Wong et al., a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In the present instance, a background process is inherent to the method and apparatus for carrying out customer loyalty and marketing analysis as described in Wong et al.

12. The applicant then argued that claims 1-16 and 30 have been amended to reflect that the process is being carried out on a personal computing device. A personal computing device is one of the devices described in Wong et al. as shown in Fig. 1 and column 3, lines 35, 37-40. The invention described in Wong et al. is not limited to use in connection with a POS as argued by the applicant.

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13. The applicant further argued “the computer program detecting instances of a credit card transaction in the entries made on the personal computing device”. The remote data capture devices as shown in Fig. 1 reflects a personal computing device. Again, please see column 3, lines 35, 37-40. Accordingly, claims 1-30 and 39-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Wong et al.

14. The applicant argued that claims 12, 24, 30 and 43 note the detection of credit card usage and requests the user to confirm stored information. The invention as described in Wong et al. offers the options for the users to update and view record information as shown in Fig. 7-9 and column 10, lines 45-51.

15. The applicant then discussed the added claims 54-57. Please see above discussion regarding these claims incorporated herein.

16. Lastly, the applicant argued that claims 31-38 and 46-53 are amended to reflect that the user is in control of the database. The invention as described in Wong et al. allows the user to search, view and update information as shown in Fig. 7-12, column 4, lines 41-64 and column 10, lines 5-59.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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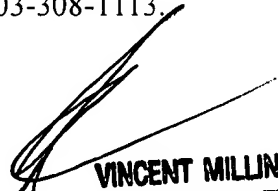
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sally Shih whose telephone number is 703-305-8550. The examiner can normally be reached on Flexible Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7658 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

sys
June 13, 2003


VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

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Response to Applicant's Argument

8. The Examiner acknowledges Applicant's arguments with respect to claims 1-53. The Applicant's arguments have been fully considered, and discussed in the next section below are not deemed to be persuasive.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-53 are rejected under 35 U.S.C. 102(e) as being anticipated by Wong et al. United States Patent Number 6,119,933 as discussed from the fourth paragraph of page 2 of paper number 4.